



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,027	01/24/2007	Urs Burckhardt	127688	8790
27049	7590	02/04/2011		
OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850			EXAMINER LEONARD, MICHAEL L.	
			ART UNIT 1763	PAPER NUMBER
			NOTIFICATION DATE 02/04/2011	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction27049@oliff.com
jarnstrong@oliff.com

Office Action Summary

Application No.

10/576,027

Applicant(s)

BURCKHARDT ET AL.

Examiner

MICHAEL LEONARD

Art Unit

1763

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-942)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The applicants' amended the claims to include limitations not previously search and/or considered in previous rejections. Therefore, it is proper to make this action FINAL.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

Claims 1-24 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of copending Application No. 11/822,111 U.S. Patent No. 4,853,454 to Merger et al. and U.S. Patent No. 5,116,931 to Reisch et al. for the reasons set forth in the last Office action.

Claims 1-24 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 12/000763 in view of U.S. Patent No. 4,853,454 to Merger et al. for the reasons set forth in the last Office action.

Claims 1-24 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/501074 in view of U.S. Patent U.S. Patent No. 4,853,454 to Merger et al. for the reasons set forth in the last Office action.

Claims 1-24 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/501078 in view of U.S. Patent No. 4,853,454 to Merger et al., and U.S. Patent No. 5,116,931 to Reisch et al. for the reasons set forth in the last Office action.

Claims 1-24 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of copending Application No. 10522412 in view of U.S. Patent No. 4,853,454 to Merger et al. for the reasons set forth in the last Office action.

Claims 1-24 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 11/470588 U.S. Patent No. 4,853,454 to Merger et al. for the reasons set forth in the last Office action.

Claims 1-24 and 26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 12/056043 in view of U.S. Patent No. 4,853,454 to Merger et al. for the reasons set forth in the last Office action.

Claim Rejections - 35 USC § 103

Claims 1-5, 9, 11-16, 19-20, 23-24 and 26-28 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,853,454 to Merger et al. in view of U.S. Patent No. 4,895,883 to Pedain et al. for the reasons set forth in the last Office action.

Claims 6-8 and 10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 4,853,454 to Merger et al. in view of U.S. Patent No. 4,895,883 to Pedain et al. that has been explained above and is applied here as such in view of U.S. Patent No. 3,935,274 to Jacobsen et al. for the reasons set forth in the last Office action.

Claims 17-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 4,853,454 to Merger et al. in view of U.S. Patent No. 4,895,883 to Pedain et al. that has been explained above and is applied here as such in view of U.S. Patent No. 5,116,931 to Reisch et al. for the reasons set forth in the last Office action.

Claims 21-22 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 4,853,454 to Merger et al. in view of U.S. Patent No. 4,895,883 to Pedain et al. that has been explained above and is applied here as such in view of U.S. Patent No. 5,194,488 to Piestert et al. for the reasons set forth in the last Office action.

Claims 1-5, 9, 11-16, 19-20, 23-24 and 26-28 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,895,883 to Pedain et al. in view of U.S. Patent No. 4,853,454 to Merger et al. for the reasons set forth in the last Office action.

Claims 6-8 and 10 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 4,895,883 to Pedain et al. in view of U.S. Patent No. 4,853,454 to

Merger et al. that has been explained above and is applied here as such in view of U.S. Patent No. 3,935,274 to Jacobsen et al. for the reasons set forth in the last Office action.

Claims 17-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 4,895,883 to Pedain et al. in view of U.S. Patent No. 4,853,454 to Merger et al., that has been explained above and is applied here as such in view of U.S. Patent No. 5,116,931 to Reisch et al. for the reasons set forth in the last Office action.

Claims 21-22 are rejected under 35 U.S.C. 103 (a) as being unpatentable over U.S. Patent No. 4,895,883 to Pedain et al. in view of U.S. Patent No. 4,853,454 to Merger et al. that has been explained above and is applied here as such in view of U.S. Patent No. 5,194,488 to Piestert et al. for the reasons set forth in the last Office action.

As to claim 1, with respect to the additional limitations, Pedain discloses wherein the two-component is sprayed onto the matrix leveled out to form a film, the viscosity rose immediately and a paste-like state was reached for about 30 to 90 seconds after spraying (Column 11, lines 33-35).

As to claims 27-28, Merger discloses wherein at least one catalyst can be included in the polyurethane composition components to accelerate the hydrolysis of the polyaldimine in the presence of moisture and the catalyst can be selected from salicylic acid and/or benzoic acid (Column 9, lines 37-47), and preferably Merger selects the use of benzoic acid (Column 12, line 19).

Response to Arguments

Applicant's arguments, see Arguments, filed 12/21/2010, with respect to written description requirement have been fully considered and are persuasive. The rejection of claims 1-24 and 26 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement has been withdrawn.

Applicant's arguments filed 12/21/2010 have been fully considered but they are not persuasive. Applicants argue that the claimed invention has not been rendered obvious by Merger ('454) in view of Pedain ('883) or Pedain in view of Merger for 3 reasons.

1) The first being the Pedain reference fails to teach a polyurethane composition that comprises fillers.

2) The second being that the Pedain reference fails to disclose a polyurethane composition with thin consistency or paste-like.

3) The third being that the polyurethane composition contains polyaldimines that react extremely fast because of the presence of non-aldiminized or free amino groups, which differs from the instant specification wherein the aldehyde is used in stoichiometric proportion or excess relative to the primary amino groups producing no non-aldiminized or free amino groups in the curative section.

In response to issue 1), Pedain discloses that auxiliaries and additives such as known leveling agents, stabilizers, catalysts and pigments may be used in the production of the polyurethane ureas according to the invention (Column 8, lines 60-64) and Merger also discloses auxiliaries and additives such as fillers, plasticizers, pigments, antioxidants, and light protecting agents may be added to the polyurethane composition without significantly impairing the advantageous properties (Column 9, lines 52-59).

In response to issue 2), Pedain discloses wherein the two-component is sprayed onto the matrix leveled out to form a film, the viscosity rose immediately and a paste-like state was reached for about 30 to 90 seconds after spraying (Column 11, lines 33-35). Furthermore, Pedain discloses wherein the viscosity rose and therefore at some point within the spray gun the polyurethane composition had to have had a thin consistency.

In response to issue 3), firstly, the claims do not disclose wherein the aldehyde component is used in stoichiometric proportion or excess relative to the primary amino groups producing no non-aldimized or free amino groups in the curative section and therefore the arguments are not commensurate in scope. Secondly, Pedain discloses different ratios of primary amino groups to aldehydes (Column 5, lines 42-69, Column 6, lines 1-2) wherein either the primary amino groups or the aldehyde is used stoichiometric proportion or excess relative to the

primary amino groups producing no non-aldiminized or free amino groups in the curative section. As a result, a person of ordinary skill in the art could routinely work through the ratios disclosed by Pedain to produce no non-aldiminized or free amino groups in the curative section or non-aldiminized or free amino groups in the curative section depending on the application of the coating and/or adhesive, how fast the reaction needs to proceed, and the dispersion apparatus used.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL LEONARD whose telephone number is (571)270-7450. The examiner can normally be reached on Mon-Fri 7:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1763

/MICHAEL LEONARD/
Examiner, Art Unit 1763